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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 61135/P004CP1CP1C2/10107404	
	Application Number 10/082,398-Conf. #5850	Filed February 25, 2002	
	First Named Inventor Salim G. Kara		
	Art Unit 3629	Examiner M. L. Brooks	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant /inventor.
 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)
 attorney or agent of record.
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Telephone number

October 6, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.



Docket No.:
61135/P004CP1CP1C2/10107404
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Salim G. Kara

Application No.: 10/082,398

Confirmation No.: 5850

Filed: February 25, 2002

Art Unit: 3629

For: **SYSTEM AND METHOD FOR PRINTING
MULTIPLE POSTAGE INDICIA**

Examiner: M. L. Brooks

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below.

REMARKS

I. 35 U.S.C. § 103(a) Rejections

Claims 1, 4-16, 19-25 and 27-36 are pending in the present application and stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sansone* et al. United States Patent Number 4,831,555 (hereinafter *Sansone*) in view of Schuessler United States Patent Number 2,964,232 (hereinafter *Schuessler*). Applicant respectfully submits that the outstanding claim rejections are improper, and thus requests pre-appeal review of the rejected claims in light of the remarks presented herein.

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references lack all the claim limitations.

Claim 1 recites “software for generating said postal item . . .” The Office Action of July 26, 2006 (hereinafter *OA*) cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. *OA* page 2. The cited lines discuss generating postage and printing the postage on a postage item such as an envelope or an insert, however *Sansone* does not teach software generating the postal item itself. As a result, *Sansone* does not disclose “software for generating said postal item . . .”

Moreover, claim 1 recites “software for generating...said postage indicia *and* for printing said postage indicia on said postal item . . .” The *OA* again cites the same lines of *Sansone* as teaching this limitation. *OA* page 2. However, nowhere in *Sansone* is it taught that the software for generating postage also prints the postage. *Sansone*’s meter unit 14 generates the postage while user computer 28 prints the postage, and *Sansone* does not disclose the software operable on meter unit 14 in any way operates on user computer 28. Col. 4, lines 31-40. Furthermore, as a security feature, *Sansone* discloses metering unit 14 is only accessible by user computer 28. Col. 3, lines 31-36. Therefore, because meter unit 14 only communicates with user computer 28, it follows that meter unit 14 does not communicate with printer 30 as is shown by figure 1. Accordingly, as the software in meter unit 14 could not control printer 30, the software in meter unit 14 for generating postage would not also be the software which prints the postage. As a result, *Sansone* does not teach “software for generating . . . said postage indicia *and* for printing said postage indicia on said postal item . . .” Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 1. Furthermore, the *OA* does not rely on *Schuessler* to cure the above identified deficiencies. Therefore, Applicant requests that the review panel reverse the 35 U.S.C. § 103(a) rejection of record for claim 1.

Claim 16 recites “generating a piece of correspondence using a computer system [and] printing...said piece of correspondence using said computer system . . .” The *OA* cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4,

lines 30-55 as teaching this limitation. *OA* page 2. However, *Sansone* fails to teach or suggest a computer system generating a piece of correspondence. Moreover, the cited lines fail to teach *Sansone*'s computer system printing a piece of correspondence, or that the correspondence is printed at all. Accordingly, *Sansone* does not teach "generating a piece of correspondence using a computer system [and] printing . . . said piece of correspondence using said computer system"

Furthermore, claim 16 recites "printing said postage indicia and said piece of correspondence using said computer system, wherein said postage indicia is printed simultaneously with printing said piece of correspondence" The *OA* cites the same lines of *Sansone* as teaching this limitation. *OA* page 2. However, *Sansone* fails to teach a computer system *simultaneously* printing a piece of correspondence and postage indicia. The cited lines disclose printing postage indicia on an envelope or insert, however, *Sansone* fails to disclose that the correspondence was printed by a computer system, what computer system printed the correspondence, or even if the correspondence was printed at all.

The *OA* states "it would have been obvious . . . to have utilized the teachings of *Sansone* to generate said postage on ones personal computer, copy and paste into document and then press print which would simultaneously produce completed correspondence." *OA* pages 4-5. Applicant disagrees. As explained, *Sansone* does not teach generating correspondence, therefore it would not be obvious to paste postage into a correspondence. Furthermore, as discussed above, *Sansone*'s meter unit 14 generates the postage, and *Sansone* does not teach nor make it obvious how a user would copy postage from meter unit 14 and paste it into a document generated on a personal computer. The *OA* uses the example of copying a jpeg and pasting it into a letter. *OA* page 5. However, *Sansone* makes no indication that the postage shares any similarities with a jpeg at all. Indeed, *Sansone* does not teach the user computer provides access to or even displays the postage prior to printing. Therefore, it would not be obvious to copy and paste *Sansone*'s postage in the manner a jpeg or any other file is copied and pasted. Therefore, Applicant respectfully asserts it would not be obvious from *Sansone*'s teachings that postage could be copied and pasted into a document and then printed. Thus, *Sansone* fails to teach "printing said postage indicia and said piece of correspondence using said computer system, wherein said postage indicia is printed *simultaneously* with printing said piece of correspondence" Accordingly,

Applicant has shown *Sansone* fails to teach each and every element of claim 16.

Furthermore, the *OA* does not rely on *Schuessler* to cure the above identified deficiencies.

Therefore, Applicant requests that the review panel reverse the 35 U.S.C. § 103(a) rejection of record for claim 16.

Claim 25 recites “[a] piece of correspondence and the postage indicia thereon are printed by a computer system operable under control of software for generating documents and postage indicia . . .” The *OA* cites *Sansone* column 4, lines 10-15 as teaching this limitation. *OA* page 2. However, *Sansone* fails to teach a computer system printing a piece of correspondence *and* the postage indicia thereon. As explained above, *Sansone* fails to disclose printing a piece of correspondence. Accordingly, *Sansone* does not teach “[a] piece of correspondence and the postage indicia thereon are printed by a computer system . . .”

Furthermore, claim 25 recites “software for generating documents and postage indicia . . .” The *OA* cites *Sansone* column 4, lines 10-15 as teaching this limitation. *OA* page 2. *Sansone*’s postage is generated by meter unit 14, and *Sansone* does not teach the software on meter unit 14 as also generating documents. Moreover, as meter unit 14 has no display to aid a user in generating a document, one would lack the motivation to make the software on meter unit 14 also generate documents. Col. 3, line 34. Therefore, *Sansone* fails to teach or make obvious “software for generating documents *and* postage indicia . . .” Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 25.

Furthermore, the *OA* does not rely on *Schuessler* to cure the above identified deficiencies. As a result, Applicant requests that the review panel reverse the 35 U.S.C. § 103(a) rejection of record for claim 25.

Claim 36 recites “printing a piece of correspondence using a computer system . . .” The *OA* cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. *OA* page 2. However, as explained above, *Sansone* fails to disclose printing a piece of correspondence whatsoever, much less a computer system printing the piece of correspondence. Accordingly, *Sansone* does not teach this limitation of claim 36.

Moreover, claim 36 recites “said piece of correspondence comprising a document generated by said computer system and a postage indicia generated by said computer system .

..." The *OA* cites the same lines of *Sansone* as teaching this limitation. *OA* page 2. However, *Sansone* fails to disclose a computer system generating a piece of correspondence and a postage indicia. While, *Sansone* teaches a computer system printing postage, *Sansone* fails to teach that any computer system generates or prints the piece of correspondence. Therefore, Applicant respectfully asserts *Sansone* fails to teach "said piece of correspondence comprising a document generated by said computer system and a postage indicia generated by said computer system . . ." Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 36. Furthermore, the *OA* does not rely on *Schuessler* to cure the above identified deficiencies. Thus, Applicant requests that the review panel reverse the 35 U.S.C. § 103(a) rejection of record for claim 36.

Claims 4-15, 19-26 and 27-35 depend from claims 1, 16 and 25 respectfully and inherit the limitations therein. Therefore, at least for the reasons set forth above, claims 4-15, 19-26 and 27-35 are not taught by *Sansone* in view of *Schuessler*. Thus, Applicant requests that the review panel reverse the 35 U.S.C. § 103(a) rejections of record for claims 5-15, 19-26 and 27-35.

II. Summary

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections in the present application. The required fee for the Notice of Appeal filed with this request is attached. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C2/10107404 from which the undersigned is authorized to draw.

Dated: October 6, 2006

Respectfully submitted,

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